

Appl. No.: 09/658,612  
Amdt. dated: April 19, 2004  
Reply to Office Action of January 30, 2004

### **REMARKS/ARGUMENTS**

These Remarks are in reply to the Office Action mailed January 30, 2004. No fee is due for the addition of any new claims.

Claims 1-6 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected Claims 1-6.

#### **I. Summary of Office Action.**

Claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Katz, U.S. Patent No. 4,834,551.

Claims 2-3 were rejected under 35 U.S.C. 103 over Katz in view of Inoue, U.S. Patent No. 6,332,024 or Cannon, U.S. Patent No. 6,393,272.

Claim 4 was rejected under 35 U.S.C. 103 over Katz in view of Grossman, U.S. Patent No. 6,122,346 or Satio, U.S. Patent No. 6,526,263.

#### **II. Summary of Applicants Response**

Applicants respectfully request reconsideration of the Examiner's rejections.

#### **III. Response to Objections and Rejections**

Claim 1 was rejected under 35 U.S.C. 102(a). Applicants respectfully request reconsideration of the rejection. Claim 1 recites:

A system for a telephone, comprising:

- (a) a mechanical device associated with a conversation element;
- (b) a memory, coupled to the mechanical device, for storing an internal conversation element representing an audible utterance for a remote listener in an ongoing conversation; and
- (c) a processor, coupled to the memory and the mechanical device, for generating the audible utterance in response to a user interaction with the mechanical device and the conversation element.

The claimed invention comprises a system for a telephone that generates audible utterances for a remote listener in an ongoing conversation. Applicants respectfully submit that Katz is deficient of the features of the claimed invention.

The Examiner, in rejecting claim 1 states in his rejection that “Katz teaches a call holding alerting system....which can place an ongoing conversation in a hold mode and generate a message that can be relayed to a remote listener”. Applicants respectfully suggest that this reading of Katz is incorrect. Katz discloses a system in which the *held* party, not the hold-initiating party can transmit a continually running message to indicate that a predetermined DTMF tone is needed to deactivate the recording, thus allowing the hold-initiating party to notify the held party that he is ready to resume the conversation(col. 1. ll 35-65)

Katz does not teach an “element representing an audible utterance for a remote listener in an ongoing conversation.” Rather, Katz teaches an automatically cycling message that is *started by the held party after the held party is put on hold.*(col.2 ll. 36-40)

Given that there is no interaction happening at the time of message transmission in the system of Katz, there is no “ongoing conversation” for which the message element is a part . The message of

Katz is not transmitted in response to a statement by a remote listener or intended to invoke a response and is thus not part of any manner of conversation, let alone an "ongoing conversation". The alternative embodiments disclosed in Katz, which discuss the transmission of messages to absent parties similarly fail to teach the features of the claimed invention.

Thus, in light of the fact that the message transmission in Katz occurs after a hold period has begun and that the message that is transmitted is not configured to respond to a statement by another party or elicit a response by another party, Applicants submit that Katz cannot be reasonably interpreted to teach a conversation element configured to be transmitted to remote listener as part of an ongoing conversation.

Regarding claims 2-6, neither Inoue, Satio, Grossman, or Cannon cure the deficiencies of Katz. Thus claims 2-6, which contain the patently distinguishable subject matter of claim 1, are likewise patentably distinguishable over the prior art.

#### IV. Conclusion

The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

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The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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